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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10-022,801	12/20/2001	Masaaki Maekawa	1417-377	3879

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NIXON & VANDERHYE P.C.  
8th Floor  
1100 North Glebe Road  
Arlington, VA 22201

EXAMINER

LE. HOA T

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/022,801

Applicant(s)

MAEKAWA ET AL.

Examiner

H. T. Le

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The instant claims require an “activation volume” of the claimed magnetic alloy particles be of 0.01 to 0.07 E-4  $\mu\text{m}^3$ . However, the specification fails to provide an adequate description as to how the claimed value of activation volume is achieved or controlled.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 and 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by ‘ 516 Okinaka et al (US 5,989,516).

Claims 1, 2, 9, and 10: ‘ 516 Okinaka et al disclose a method of making spindle-shaped magnetic alloy particles: comprising Fe and Co as the main components; having (1) a Co

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content of from 8 to 50 atm% based on the total amount of Fe, in particular 36 atm% (col. 12, lines 24-26); (2) an average major axis diameter of 0.05 to 0.12  $\mu\text{m}$  (col. 12, lines 28-32); (3) a crystallite size ( $D_{110}$ ) of 80 to 150  $\text{\AA}$  (see col. 13, lines 38-40); and a coercive force of 1850 to 2500 Oe (col. 21, lines 1-5 and 33-42). Note that the aforementioned spindle-shaped magnetic alloy particles are according to the second embodiment as disclosed in the ‘ 516 Okinaka reference. ‘ 516 Okinaka does not measure the activation volume of the magnetic alloy particles; however, such value of activation volume as claimed is deemed inherent because activation volume as measured according to the instant disclosure is just a change in magnetization of the particles. In this case, because the magnetic alloy particles taught by ‘ 516 Okinaka contain the same main components, same cobalt content, have the same dimensions and possess the same magnetic properties (i.e. coercive force and squareness) as those of the claimed magnetic particles, it is necessarily inherent that the particles taught by ‘ 516 Okinaka exhibit the same change in magnetization and thus the same activation volume.

Claim 3: col. 8, lines 47-49.

Claims 4 and 11: Rh value is another magnetic property; therefore, it is deemed met by inherence as the magnetic alloy particles taught by Okinaka contain the same main components, same cobalt content, have the same dimensions and possess the same magnetic properties (i.e. coercive force and squareness) as those of the claimed magnetic particles

Claim 5: Table 8 (col. 49, lines 60-66).


Claim 7: col. 24, lines 52-56.

Claims 8 and 12: Table 10, col. 52, lines 20-25. The orientation degree and oxidation stability are deemed met by inherence because they are derivative properties of the squareness ratio. In this case the magnetic recording medium of the '516 Okinaka reference possess the same squareness ratio as the claimed magnetic recording medium (as shown in Table 10).

Claim 13: See rejections of claims 1-5 and 7-12.

5. Other references are cited as art of interest.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 703-308-2415. The examiner can normally be reached on 10:00 a.m. to 8:30 p.m., Mondays to Friday.

hl  
June 30, 2003

  
H. T. Le  
Primary Examiner  
Art Unit 1773